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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/218,119	12/21/1998	ANDREW M. PROEHL	80398-P158	3529

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EXAMINER	
LONSBERRY, HUNTER B	

ART UNIT	PAPER NUMBER
2611	22

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/218,119	PROEHL ET AL.	
	Examiner	Art Unit	
	Hunter B. Lonsberry	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-18,21-32,36,37,43-48,50-52 and 58-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-18,21-32,36,37,43-48,50-52 and 58-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 1/13/2004 have been fully considered but they are not persuasive.

1) Applicant argues "Both Lawler and Cragun disclose deliberate, manual input from the thus and thus contain no suggestion that allowing the user an impulse choice would be advantageous. The incomplete reasoning of the Examiner and the lack of a clearly supported motivation indicate that the examiner is selectively extracting elements from the prior art and arranging them to fit Applicants claimed invention." (Page 10)

Regarding applicant's argument 1, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, Lawler allows a user to set a reminder/recording command for a future program, while browsing upcoming programs in a program guide (Column 10, line 27-column 11, line 17). Cragun is merely relied upon for teaching a notification locally,

whereas Lawler discloses that reminder information is transmitted via the headend, additionally, Cragun discloses capturing/saving programming from the searches (column 9, lines 15-65). Diehl is relied upon for enabling a user to decide to record a future program on impulse, from watching an advertisement for an upcoming broadcast. Diehl's impulse option is advantageous as, as the user does not need to browse programming. Cragun, Diehl and Lawler are related art and require active participation of the user to select a program to be recorded/reminded in the future.

2) Applicant argues that none of the references disclose a first notification, issued in response to a first signal generated by a viewing during an advertisement, and presents a menu to indicate viewer interest or disinterest, and a second signal resulting in a viewer menu selection. "It is unclear from the examiners arguments what signal now triggers Diehl's extraction. Is the signal from Florin or is it the reminder from Lawler?" (Page 9,10)

Regarding applicant's argument 2, Lawler discloses a reminder system in which a user browses program listings in a program guide, and then sets a reminder or record command, the user first presses an action button while browsing after which a reminder options menu is displayed, the examiner considers the action button press to be the first signal, the menu to be the notification, and the user selection the remind 144 (this show) or cancel 134 buttons to be the second signal indication viewer interest or disinterest. Diehl is relied upon for enabling a user to decide to record a future program on impulse, from watching an advertisement for an upcoming broadcast. Diehl's extraction would then be triggered by the user deciding to issue a reminder.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-18, 21-32, 36, 37, 43-48, 50-52, and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,699,107 to Lawler in view of, U.S. Patent 5,659,653 to Diehl and U.S. Patent 5,859,662 to Cragun.

Regarding claims 11 and 43-45, Lawler discloses a program reminder system in Figures 4 and 6, in which a user selects a TV program from a program guide which they wish to view at a later date via remind button 140 or cancel button 132, the program guide provides descriptive information on the program, five seconds before the program's start time a reminder is generated in a window which is placed over the currently watched program (Figure 9, column 12, lines 35-43, 53-63), the examiner considers the action button press to be the first signal, the menu to be the notification, and the user selection the remind 144 (this show) or cancel 134 buttons to be the second signal indication viewer interest or disinterest. Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and

Data Extractor 12 retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Cragun discloses a system in which a user inputs keywords for a search parameter, a local CPU then executes a program to scan the close captions of incoming video programs for words or phases which match the search and notifies the user (Figures 8-10, column 5, line 49-column 6, line 8, lines 40-58, column 7, lines 4-column 9, line 65, column 12, lines 41-59, column 15, line 60-column 16, line 57). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the reminder system of Lawler to store program information for an upcoming program locally, retrieving program information and issuing a record command after viewing an advertisement for an upcoming program, as taught by Diehl, and generating a notification locally as taught by Cragun thus providing a number of impulse program choices to a user.

Regarding claim 12, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6).

Regarding claim 13, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9, column 12, lines 35-43, 53-63).

Regarding claim 14, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program (column 13, lines 1-6).

Regarding claim 15, see claim 14.

Regarding claim 16, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program and tunes to the proper channel (column 13, lines 1-6).

Regarding claim 17, see claim 13.

Regarding claim 18, Lawler discloses in Figure 2 an action key 70 that is used by a subscriber to select a television program (column 13, lines 1-6).

Regarding claim 21, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6). Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and Data extractor retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Cragun discloses a system in which a user inputs keywords for a search parameter, a local CPU then executes a program to scan the close captions of incoming video programs for words or

phases which match the search and notifies the user (Figures 8-10, column 5, line 49-column 6, line 8, lines 40-58, column 7, lines 4-column 9, line 65, column 12, lines 41-59, column 15, line 60-column 16, line 57). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the reminder system of Lawler to store program information for an upcoming program locally, retrieving program information and issuing a record command after viewing an advertisement for an upcoming program, as taught by Diehl, and generating a notification locally as taught by Cragun thus providing a number of impulse program choices to a user.

Regarding claim 22, Lawler discloses in Figure 9, a program reminder system that superimposes a program-viewing window over the currently watched program.

Regarding claims 23 and 24, Lawler discloses in Figure 9, a program reminder system that displays a TV program reminder in a window prior to the beginning of a program and switches to a reminded program (column 12, lines 35-43, 53-63, column 13, lines 1-6)). Lawler also discloses in Figures 6 a program guide (Figure 6) with a remind button 140 and cancel button 132. The combined system of Lawler, Cragun and Diehl does not disclose a reminder system, which includes a button in the notification window, but instead utilizes a button 70 on the remote control when then tunes to the program with the reminder (column 13, lines 1-6). Therefore it would have been obvious to one skilled in the art at the time of invention to modify the combined system of Lawler, Florin, Cragun and Diehl to display a button to indicate interest instead pressing a button on the remote control thereby reducing the number of buttons on a remote control and increase usability of the system

Regarding claim 25, Lawler discloses a program reminder system, which provides a second reminder five seconds before the program's start time; the user can then tune to the program (column 12, lines 35-43, 53-63).

Regarding claim 26, Lawler discloses in Figure 2, a video display 20 and in Figure 9, a reminder notification 152 overlaid on a TV program.

Regarding claim 27, Lawler discloses in Figure 9, a program reminder system that displays a TV program reminder in a window prior to the beginning of a program and tunes to the program once a user presses a button 70 on the remote control (column 13, lines 1-6).

Regarding claim 28, Lawler discloses that the user presses a button 70 on the remote control to tune to the programming (column 13, lines 1-6).

Regarding claim 29, Lawler discloses that the user presses a button 70 on the remote control to tune to the programming (column 13, lines 1-6), and analog or digital decoder is used to tune and decode the picture (column 6, lines 7-23).

Regarding claim 30, Lawler discloses a program reminder system that displays a reminder to a user several minutes before each designated program is to start (column 12, lines 53-63).

Regarding claim 31, Lawler discloses in Figure 6, a program guide with a reminder button 140 which a user uses to create a future program reminder event (column 13, lines 7-16).

Regarding claim 32, Lawler discloses in Figure 6, a program guide calendar which a user may use to set a reminder to watch a show in the future by pressing a remind button 140.

Regarding claim 36, Lawler discloses a program reminder system in Figures 4 and 6, in which a user selects a TV program from a program guide which they wish to view at a later date via remind button 140 or cancel button 132, the program guide provides descriptive information on the program, five seconds before the program's start time a reminder is generated in a window which is placed over the currently watched program (Figure 9, column 12, lines 35-43, 53-63). Lawler does not disclose a system in which the reminder notification appears during a commercial advertisement or storing the reminder information locally. Diehl discloses a system in which a user presses a learn button during an advertisement for an upcoming broadcast of a program that the user is interested in, by pressing the learn button, CPU 29 queries TV 16 and Data extractor retrieves the program information and transfers it to the CPU, the VCR then programs itself to record the program (column 4, lines 10-column 5, line 33). Cragun discloses a system in which a user inputs keywords for a search parameter, a local CPU then executes a program to scan the close captions of incoming video programs for words or phases which match the search and notifies the user (Figures 8-10, column 5, line 49-column 6, line 8, lines 40-58, column 7, lines 4-column 9, line 65, column 12, lines 41-59, column 15, line 60-column 16, line 57). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the reminder system of Lawler to store program information for an upcoming program locally, retrieving program

information and issuing a record command after viewing an advertisement for an upcoming program, as taught by Diehl, and generating a notification locally as taught by Cragun thus providing a number of impulse program choices to a user.

Regarding claim 37, Lawler discloses a program reminder system which provides a second reminder five seconds before the program's start time which is overlaid over the currently watched program (Figure 9); the user can then tune to the program action button 70 if they are interested in viewing the program (column 12, lines 35-43, 53-63, column 13, lines 1-6).

Regarding claim 46 and 58, Lawler discloses in Figure 2, a CPU 58 inside of STB 18 which controls display 20 (column 5, lines 58-column 6, line 6).

Regarding claims 47, 48, 59 and 60, Lawler discloses that the STB is controlled via an IR remote control 22 (column 5, lines 58-column 6, line 6). Remote control 22 inherently contains a processor in order to interpret user input into commands to transmit via the infrared spectrum.

Regarding claim 50, Lawler discloses in Figure 2, a CPU 58 inside of STB 18 which controls display 20 (column 5, lines 58-column 6, line 6).

Regarding claims 51 and 52, Lawler discloses that the STB is controlled via an IR remote control 22 (column 5, lines 58-column 6, line 6). Remote control 22 inherently contains a processor in order to interpret user input into commands to transmit via the infrared spectrum.

Claims 49 and 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,699,107 to Lawler in view of U.S. Patent 5,659,653 to Diehl and Patent 5,859,662 to Cragun in further view of U.S. Patent 5,990,927 to Hendricks.

Regarding claim 49, Lawler discloses in Figure 2, a set top box 18 with an analog decoder 42 for decoding broadcast TV, a network communication interface 56 for decoding control signals from the headend, a CPU 58 which delivers or requests information to/from the headend and controls selection of programming as well as the program guide (column 6, lines 7-31) column 7, lines 8-16). Hendricks discloses a EPG and reminder system which retrieves program information from the headend, a user selects a program which they wish to record (Figure 15), the recording information is stored locally to later be sent to a VCR, prior to the recording time a reminder screen (Figure 22) is displayed (column 33, lines 34-58, column 40, lines 55-column 41, line 60). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler/Diehl/Cragun to store the reminder information locally and be able to select programming to record as taught by Hendricks thereby allowing a user to impulse select a program to view.

Regarding claim 57, Lawler discloses in Figure 2, a set top box 18 with an analog decoder 42 for decoding broadcast TV, a network communication interface 56 for decoding control signals from the headend, a CPU 58 which delivers or requests information to/from the headend and controls selection of programming as well as the program guide (column 6, lines 7-31) column 7, lines 8-16). Diehl discloses storing a record request locally (column 4, lines 10-column 5, line 33). Lawler, Diehl and Cragun

do not disclose displaying a 2nd notification to record prior to the start time of the broadcast. Hendricks discloses a EPG and reminder system which retrieves program information from the headend, a user selects a program which they wish to record (Figure 15), the recording information is stored locally to later be sent to a VCR, prior to the recording time a reminder screen (Figure 22) is displayed (column 33, lines 34-58, column 40, lines 55-column 41, line 60). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Lawler/Cragun and Diehl to transmit a second notification prior to the recording start time to make sure that a video tape is loaded into the VCR to record on.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 703-305-3234. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-308-5359.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

VIVEK SRIVASTAVA
PRIMARY EXAMINER

HBL